

Appl. No.: 09/990,770
Dated Nov. 2, 2005
Reply to Final Office Action of Sept 2, 2005

Remarks In Response to the Office Action

A. General Remarks

Claims 1-45 are pending in the application. No claims have been added, cancelled, or amended in this Reply.

B. Double Patenting Rejections

1. Claims 1-45 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-39 of co-pending application Serial No. 09/991,561 and claims 1-36 of co-pending application Serial No. 11/058,775.

In response, Assignee submits a terminal disclaimer directed to co-pending application Serial No. 09/991,561 and co-pending application Serial No. 11/058,775. This terminal disclaimer is filed as permitted by MPEP 804.02(IV). In light of the filing of this terminal disclaimer, Assignee respectfully requests that the double patenting rejections to co-pending application Serial Nos. 09/991,561 and 11/058,775 be reconsidered and withdrawn.

2. Claims 1-45 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as claiming the same invention as that of claims 1-21 of U.S. Patent No. 6,944,630 ("the '630 Patent"). The Final Office Action states:

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are arguably broader than claim 1 in VOS et al. '630 which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations in the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See In re Karlson, 136 USPQ 184.
[Final Office Action, pg. 3, ¶ 4]

Applicants respectfully traverse the rejection of claims 1-45 under the judicially created doctrine of obviousness-type double patenting. First, none of the claims in the '630 Patent recites any limitations directed to one or more policies, one or more definitions, determining actions based on policies or definitions, nor reconfiguring one or more policies. Accordingly, the

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claims in the '630 Patent do not encompass *the same metes, bounds, and limitations*, as contended in the Final Office Action, and the claims in the instant application are patentably distinct from those in the '630 Patent.

Second, the rejection offers the rationale from *In re Karlson* that omission of an element and its function in a combination is obvious if the remaining elements perform the same functions as before. For this rationale to apply, it must be shown that the claims in the instant application perform the same function as the claims in the '630 Patent. By way of example, claims in the '630 Patent are directed to "collecting statistics ...; determining characteristics of the database objects; determining actions....based on the characteristics....; automatically determining a schedule....based on the activity-level statistics; performing the actions...based on the schedule;...and monitoring results of the performing the actions..." Independent claim 1 in the '630 Patent. In contrast to the '630 Patent and by way of example, claims in the instant application are directed to "associating one or more policies or definitions with the database for managing database objects; determining actions...based on the one or more policies or definitions; modifying the one or more database objects...; monitoring results ...; and reconfiguring the one or more policies or definitions...based on the results..." Independent claim 1 in the instant application.

In general, claims in the '630 Patent are directed to determining and performing actions on database objects based on characteristics and statistics, whereas claims in the instant application are directed to determining and performing actions on database objects based on policies or definitions associated with them and directed to reconfiguring the policies or definitions based on monitored results of the actions. Thus, when compared with each other, claims in the instant application do not perform the same functions as claims in the '630 Patent, and the rationale for obviousness presented in the Final Office Action is not applicable to these claims.

Accordingly, claims 1-45 in the instant application are not obvious over the claims in the '630 Patent because the claims (1) do not encompass the same metes, bounds, and limitations and (2) do not perform the same functions. Assignee respectfully requests that the rejection of

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claims 1-45 under the judicially created doctrine of obviousness-type double patenting be reconsidered and withdrawn.

C. Claim Rejections - 35 USC § 102

Claims 1-45 stand rejected under 35 U.S.C. 102(e) as being anticipated by Agarwal et al. (U.S. Pat. No. 6,370,522 B1). Assignee respectfully traverses the conclusion that Agarwal et al. anticipates the listed claims 1-45 in so far as Agarwal et al. does not disclose all the limitations of independent claims 1, 16, and 31.

1. Legal Principles

"For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference."¹ Further, the "identical invention must be shown in as complete detail as is contained in the patent claim"² and the "elements must be arranged as in the claim under review."³ Thus, for Agarwal et al. to anticipate claims 1-45, Agarwal et al. must disclose each element as arranged in the claims and in as complete detail as contained in the claims.

2. Assignee's claims

Each of Assignee's claims 1 to 45 is directed to automated database management. For example, claim 1 requires that one or more policies or definitions be associated with a database for managing database objects. During automated database management, actions are determined. The actions are to be performed on one or more database objects to modify them based on the one or more policies or definitions. *The database objects are modified by performing the actions on the database objects, and results of modifying the database objects are monitored. In addition, the one or more policies or definitions associated with the database are reconfigured based on the results of modifying the database objects.*

¹ *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 (Fed. Cir. 1988).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir.), *cert. denied*, 493 U.S. 853 (1989)

³ *In re Bond*, 910 F.2d 831, 832 Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990)). *See also* M.P.E.P. 2131.

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3. Review of Agarwal et al.

Agarwal et al. appears to be directed to optimizing responses to SQL statements when a database system encounters non-native objects for which it does not have built-in support. See Agarwal et al. at Abstract, col. 3, ll. 31-32, and col. 4, ll. 48-54. Agarwal et al. disclose an optimizer (202) that receives a query directed to a database system in the form of an SQL statement (222) that has a predicate. The predicate involves a registered object or type of object. The optimizer (202) generates possible execution plans (214) involving the object and uses a cost function to estimate the costs of the execution plans (214). The estimated costs for each execution plan (214) are compared, and the optimizer (202) selects the execution plan (214) with the lowest relative cost. See Agarwal et al. at col. 4, ll. 20-47; Figures 1 and 2; See also Agarwal et al. at col. 44, ll. 16-25.

4. Rejection in the Final Office Action

In rejecting claims 1-45 as anticipated by Agarwal et al., the Final Office Action selects various portions of Agarwal et al. and contends that those selected portions teach or suggest Assignee's claim limitations. Assignee's claims must be considered in their entirety when compared to Agarwal et al. The portions selectively picked from Agarwal et al. do not describe each of Assignee's claimed limitations as arranged in the claims nor in as complete detail as contained in the claims. Therefore, as a matter of law, Agarwal et al. cannot anticipate claims 1-45.

In a first example, the Final Office Action argues that Agarwal et al. at col. 15, lines 36-67 teaches and suggests Assignee's limitation pertaining to determining actions because "determining actions' reads on 'create.'" *Final Office Action*, pg. 4, ¶ 6. Actually, Agarwal et al. discloses that a "creator" (*i.e.*, an administrator of a computer system) can elect to have only a single granularity of cost/selectivity functions, which are used to estimate the costs of execution plans. "Determining actions to be performed on one or more database objects to modify the one or more database objects based on the one or more policies or definitions" as recited in claim 1, for example, does not read on having an administrator make a choice as to how detailed a cost/selectivity function should be. For one, the cost/selectivity function is used to estimate the cost of execution plans and is not disclosed as actions that are determined to

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modify database objects, as is required in Assignee's claims. Second, having an administrator perform such a function is not directed to automated database management, as are Assignee's claims.

In a second example, the Final Office Action argues that Agarwal et al. at col. 14, lines 1-25 teaches and suggests Assignee's limitation of performing actions because "'performing actions' reads on 'registration is being made...and...alternative execution plan.'" *Final Office Action*, pg. 4, ¶ 6. Actually, Agarwal et al. discusses an association table (505) for the optimizer (202) in which object types having a cost function are registered with particular objects in a database system. This association table (505) is used to call the cost function for the object type of an associated object in an SQL statement. *See* Agarwal et al. at col. 13, line 61 to col. 14, line 25 and Figure 5. "Modifying the one or more database objects by performing the actions on the database objects" as recited in claim 1, for example, does not read on having an association table that registers object types having a cost function with particular objects in a database system.

In a third example, the Final Office Action argues that Agarwal et al. at col. 5, lines 16-30 teaches and suggests monitoring results of modifying the database objects. *Final Office Action*, pg. 4, ¶ 6. Actually, Agarwal et al. discusses the optimizer (202) has the goal of minimizing resource use necessary to process SQL statements. Hints (224) are passed to the optimizer (202) within the SQL statements to the optimizer (202). *See* Agarwal et al. at col. 5, lines 16-30. Passing hints in an SQL statement so that an optimizer can process the SQL statements using fewer resources does not disclose monitoring results of performing determined actions on database objects to modify the databases object as required in Assignee's claims.

Finally, the Final Office Action argues that Agarwal et al. at col. 4, lines 30-50 teaches and suggests Assignee's limitation pertaining to reconfiguring the one or more policies or definitions associated with the database based on the results of modifying the database objects because "'policies' reads on 'execution plans'" and "'modifying the database objects' reads on 'objects...which does not build in support.'" *Final Office Action*, pg. 4, ¶ 6. Actually, Agarwal et al. discloses optimizing responses to SQL statements when a database system

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encounters non-native objects for which it does not have built-in support. *See* Agarwal et al. at Abstract and col. 4, ll. 48-54. As noted previously, the optimizer (202) in Agarwal et al. receives an SQL statement (222), generates possible execution plans (214), estimates the costs of the execution plans (214), and simply selects the execution plan (214) with the lowest relative cost. *See* Agarwal et al. at col. 4, ll. 20-47; Figures 1 and 2. There is no teaching or suggestion in Agarwal et al. of modifying database objects by performing determined actions on the database objects, monitoring results of performing the determined actions, and reconfiguring one or more policies or definitions that are associated with the database object and that are used to determine the actions to modify the database objects, as required in Assignee's claims.

The Examiner's rejection uses selectively picked portions and language from Agarwal et al. and attempts to suggest from those selective portions that Agarwal et al. discloses the limitations of Assignee's claims. As evidenced above, however, the contrast between Assignee's claims 1-45 and what is actually disclosed in Agarwal et al. shows that Agarwal et al. fails to disclose the limitations of Assignee's claims and that Agarwal et al. does not describe Assignee's claimed limitations in as complete detail as contained in the claims. Therefore, Agarwal et al. cannot anticipate claims 1-45. Withdrawal of the rejection is respectfully requested, and allowance of claims 1-45 is requested in the next paper from the Office.

D. Conclusion

No fees are believed due at this time. The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application. Should any fees be due for any reason, the undersigned representative authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 501922, referencing order no. 149-0046US.

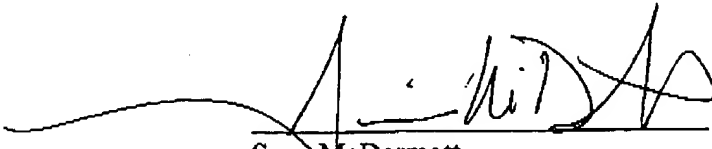
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To facilitate the resolution of any issues or questions presented by this paper, Assignee respectfully requests that the Examiner directly contact the undersigned by phone to further the discussion, reconsideration, and allowance of the claims.

Respectfully submitted,

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